

REMARKS

This is a full and timely response to the non-final Official Action mailed March 10, 2004. Reconsideration of the application in light of the above amendment and the following remarks is respectfully requested. Claims 1-25 are pending in this application, and claims 1-25 have been rejected. Claims 6, 7, 16 and 17 have been amended and claim 26 added to better define the invention in light of the specification. Support for the amendments can be found in the specification, paragraphs 24, 27 and 30. The specification has also been amended to correct errors and typos. No new matter is introduced by the amendments.

Rejection – 35 U.S.C. § 103

The Office has rejected claims 1-25 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art (APA) or EP '017 in view of Yang et al. and NPL (Baccaro et al.). In particular, the Office rejected the claims because “it would have been obvious to one of ordinary skill in the art to construct or provide the buffer tubes of the APA or EP '017 out of an alloy of a polymer mixture consisting of HIPS and SBS in view of the teachings of Yang et al. and NPL.” Office Action, page 2, paragraph 2. The Office asserts that the suggestion or motivation, as found in Yang et al. and NPL, for using an alloy of different polymers as materials for buffer tubes is “to provide better mechanical, chemical and electrical properties.” Office Action, page 3, paragraph 2. Applicant respectfully traverses the rejection.

To establish a prima facie case of obviousness, the Office must show, among other things, that the prior art references when combined “teach or suggest all the claim limitations.” M.P.E.P. § 2143. The Office, however, has not shown that the APA or EP '017 in view of Yang et al. and NPL teach or suggest any or all of Applicant’s claim limitations. In particular, the Office has not shown that Yang et al. or NPL teaches a buffer tube

comprising HIPS, SBS, CPS, ABS, SAN, SMA, SMMA or a combination thereof. Rather, NPL is directed to the study of polycarbonate (PC), polybutylene-terephthalate (PBT), non-impact modified PBT-PC, and non-impact modified polyphenylene oxide-styrene buffer tubes. (see Baccaro et al., page 147, col. 1). Yang et al. is directed to polypropylene-polyethylene buffer tube materials containing a nucleating agent or filler material. (Yang et al., col. 2, lines 19-26, 30-35). Since the Office has not properly established a prima facie case of obviousness, Applicant respectfully requests withdrawal of this ground of rejection.

Finally, the Office stated that “the different volume percents of polymer mixture and values or ranges of flexural modulus are deemed obvious design choice through routine experimentation.” See Office Action, page 3, paragraph 2. Rejecting a claim as an “obvious design choice” first requires a prior art reference to teach “the general conditions of [the] claim.” See M.P.E.P. § 2144.05 (quoting *In re Aller*, 105 USPQ 233, 235 (CCPA 1955)). There must then be a “teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify” the prior art reference with the alleged “design choice.” See *In re Chu*, 36 USPQ2d 1089, 1095 (1995) (holding that placement of the catalyst in the bag retainer “would not have been merely a matter of ‘design choice’ [since] there was no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify the Szymanski structure to place the . . . catalyst within [the] bag retainer”); see also *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.).


The Office, however, has not provided sufficient reasoning to substantiate the assertion of obvious design choice. In particular, the Office has not cited any motivation, suggestion or reference in support of the assertion that a “buffer tube comprising a polymer mixture with a flexural modulus ranging from about 150 to about 360 kpsi” is an obvious

design choice. The Office also has not provided any support for the assertion that a buffer tube polymer mixture that "comprises about 80 to about 95 volume percent HIPS and about 5 to about 20 volume percent SBS" is an obvious design choice. The Office thus has not established a prima facie case of obviousness. Accordingly, Applicant respectfully requests withdrawal of this ground of rejection.

CONCLUSION

Since none of the references, alone or in combination, disclose or make obvious the invention as now claimed, Applicant respectfully requests the Office to withdraw the pending grounds of rejection and allow the pending claims. If there is any fee due in connection with the filing of this Request for Reconsideration, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 18-0013/64671.0481.

Respectfully Submitted,

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